

REMARKS

The Office Communication mailed April 9, 2007 has been received and its contents carefully considered. The Office Communication takes the position that the reply filed by Applicants on January 12, 2007 was not fully responsive to the prior (September 12, 2006) Office Communication, and identifies certain issues related thereto. The Examiner's courtesy in noting that the January 12, 2007 filing was a *bona fide* effort to advance prosecution is noted with appreciation. Applicants wish to continue to take appropriate steps at this time to advance prosecution of the application.

This Response intends to address each of the issues mentioned in the April 9, 2007 Communication. For the reasons set forth below it is respectfully submitted that the response filed January 12, 2007 was fully responsive, and in any event, is fully responsive when considered in view of the clarifying remarks provided below.

The first issue raised in the Office Communication is that "*there appears to be only one figure on file in the application, even though the specification talks about more figures.*"

Applicants very respectfully traverse this issue. To the undersigned's understanding, this application was filed with a single figure, Figure 1. Therefore, it is unclear what other figures are being referred to in the Office Communication. This application has had a lengthy prosecution including numerous office action amendments and at least one RCE. However, it appears to Applicants that this is the first time that any issue is being raised with regard to the number of figures in the present application. Applicants sincerely regret if anything related to the figures which occurred during the lengthy prosecution of this application has been overlooked in this reply. In this regard, if the Examiner believes there are issues with the

number of figures in this application, it is respectfully requested that the next office action identify specifically a portion of the specification or a portion of a particular amendment which has raised this inquiry.

The second issue raised in the Office Communication is that *"it is not clear at this time whether the new additional language to the claims is in fact directed to an alternate embodiment not previously considered by the Examiner which would need to an election by original presentation and thereby make the response of January 12, 2007 not responsive in that such is an impermissible shift at this time, and all the claims have been amended to contain new subject matter believed to be based on an alternate embodiment not previously examined."* In this regard, it is respectfully submitted that the Examiner is correct that the January 12, 2007 amendment adds an additional feature to the claims of a skin formed on at least one of an inner surface (of a tubular first layer) and an outer surface (of a jacket). The Office Communication is also correct that this feature has not been recited in the claims to date.

However, as a matter of law and Patent Office practice, Applicants are not aware of a rule which prevents the addition of a specific claim limitation in the present situation. (It is noted that the Office Communication did not assert that this limitation was new matter, and indeed the response filed January 12, 2007 identifies portions of the specification which support this claim limitation.) Moreover, the application is not under final rejection, and therefore it is believed that amendments that do require further consideration and/or search are still proper to be amended at this non-final office action stage.

Applicants are not clear whether *"election by original presentation"* is being used in the Office Communication to be the same as, or different than, *"an impermissible shift."* However, in this regard Applicants refer the Examiner to MPEP 821 entitled "Treatment of Claims Held

To Be Drawn to Non-elected Inventions.” This is part of a chapter in the MPEP titled
“Restriction in Applications Filed Under 35 USC 1.111; Double Patenting.”

It is the undersigned’s experience that the issue of *impermissible shift* occurs only where there has been a ` in the application. In the present application, it is believed that no restriction or election of species has occurred. Therefore, since the Applicants have not elected any one embodiment, the presentation of the claim amendments is not believed to be any kind of a shift away from such an embodiment which was never elected in the first place. To the contrary, since there has been no restriction or election of species, Applicants believe they are entitled to add features to the claims during this non-final office action stage. If the Examiner wishes to maintain this objection in the future, it is respectfully requested that the Examiner identify which portion of the MPEP or CFR is being relied upon so that Applicants can understand the basis for the objection. Further, if Applicants have overlooked some aspect of the prosecution which is not mentioned here, Applicants respectfully apologize and ask the Examiner to point out what event in prosecution (such as a restriction or election of species) is being relied upon.

The third issue raised in the Office Communication is a notation that “*there is no specific arguments set forth describing how the additional language reads over the prior art rejections, nor is there any arguments directed at the new claim setting forth how it reads over the prior art rejections.*” In this regard, it is noted that the Remarks to the January 12, 2007 amendment noted that all of the amended claims recite that “the first layer has an inner surface and that the jacket has an outer surface,” and that “a skin is formed on at least one of the inner surface and/or the outer surface.” Further, with regard to the new claim, the Remarks noted that “claim 20 is newly added and recites that a skin is formed on both the inner surface and the outer surface.” The Remarks to the Amendment further noted with regard to the references used in the rejections,

that “none is believed to teach or suggest the presently recited feature of forming a skin on at least one of the inner or outer layer of a hose assembly having the other features of the layers as recited in the remainder in each of these claims, respectively.”

Applicants very respectfully submit that such an argument is appropriate in the present situation where a new previously unrecited feature is being added by amendment, and such feature is completely *absent* from any of the references used in the rejection. It is difficult for Applicants *to identify a portion of each reference that fails to disclose* the feature, since it is the entirety of the references themselves that completely lack this feature anywhere in them. Applicants believe they have recited a feature which is neither taught nor suggested by the references, and have identified that feature with particularity. Detailed regurgitation of the contents of each reference (not having the feature) is not believed to make any clearer that the feature is lacking.

Once again, if Applicants have overlooked some specific aspect of the prosecution of this application, including the numerous Office Actions and Amendments, which is inconsistent with the position being taken by the Applicants at the present time, it is respectfully submitted that such issues be addressed in the next Office Action, including an identification of the specific Office Action, claim amendment, or Remarks that are believed inconsistent with Applicants' position.

In view of the foregoing, entry of the January 12, 2007 amendment, along with these supplemental remarks, is respectfully requested. Reconsideration and allowance of the application are believed in order and such action is respectfully solicited. The Examiner is invited to contact the undersigned in an effort to resolve any matter still outstanding before issuing another action.


Docket No. 79287.21620
Serial No.: 09/827,042
Customer No. 30734

Patent

In the event any extensions of time are required for this paper to be considered timely, Applicants hereby make a conditional petition therefor. Please charge any deficiencies in fees and credit any overpayments to Deposit Account No. 50-2036 with reference to Attorney Docket No. 79287.21620.

Respectfully submitted,

BAKER & HOSTETLER LLP

A handwritten signature in black ink, appearing to read "L. Jennings", is written over the printed name.

Leo J. Jennings
Reg. No. 32,902

Date: July 9, 2007
Washington Square, Suite 1100
1050 Connecticut Avenue, NW
Washington, DC 20036-5304
Telephone: 202-861-1500
Direct: 202-861-1696
Facsimile: 202-861-1783